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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,569	01/10/2002	Paul R. Goudy JR.	GUDYP102USD	1779

7590 11/16/2005

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EXAMINER
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MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/046,569

**Applicant(s)**

GOUDY, PAUL R.

**Examiner**

Kishor Mayekar

**Art Unit**

1753

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-103 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 26-103 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

1. Applicant's arguments with respect to claims 7-25 have been considered but are moot in view of the new ground(s) of rejection.

### *Specification*

2. The disclosure is objected to because of the input electrode 584 is still not corrected throughout as -854-- in the revision to the specification page 51. Appropriate correction is required.
3. Claim 9 is objected to because of the inclusion of the phrase "(Original)" in line 2 of the claim. The phrase needs to be deleted. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 7-12, 21, 22, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Creighton (US 5,766,447). Creighton's invention is directed a device for treating an aqueous solution in which a pulsed electric field is generated in the aqueous solution between two electrodes. Creighton discloses in Figs. 1, 2(a and b), 4(a and b) and 6(a and b) that the device in plural embodiments comprises the recited first electrodes, charging path, pair of counter electrodes. As to the recited discharge sites and charging path being related for charging the discharging sites in series and discharging the discharging sites in parallel, it is inherently in Creighton's device because of the same configuration of the first electrodes to the counter electrodes as the invention.

As to the subject matter of claim 9, Creighton discloses that the first electrode is in the form of a thin wire (col. 5, lines 55-56) or needle (Fig. 6a).

As to the subject matter of claim 12, Creighton discloses that the dielectric material is glass and preferably barium titanate (col. 5, lines 49-54).

As to the subject matter of each of claims 21 and 25, Creighton discloses it in Figs. 1, 2b, 4b and 6a.

6. Claims 13-20 and 23 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Creijghton '477. The differences between Creijghton as applied above and the instant claims are the recited holder as claimed in claims 13-18, woven first electrode as claimed in claim 19, first electrode being a wire in helical shape as claimed in claim 20, and further electrode being wrapped conductor as claimed in claim 23.

As to the recited holder, since Creijghton discloses the use of spiral shape electrode in the form of thin wire (col. 5, lines 55-57) or the introducing of the gas into the device via the inlet aperture 28 of an electrically insulating resin tube 29 onto which electrode are formed (col. 6, lines 42-47 and Fig. 2(a and b)), the provision of a holder in Creijghton to maintain the spiral shape of the electrode or the provision of any equivalent electrode-holding configurations would have been within the level of ordinary skill in the art. Further, the motivation to make a specific structure is always related to the properties or uses one skilled in the art would expect the structure to have, *In re Newell* 13 USPQ 2d 1248, *Fromson v. Advance Offset Plate* 225 USPQ 26; *In re Gyurik* 201 USPQ 552. The motivation is also applied to the remaining claims 19, 20 and 23.

***Response to Arguments***

7. Applicant's arguments filed August 25, 2005 have been fully considered but they are not persuasive because of the new ground of rejections as set forth in the above paragraphs.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kishor Mayekar  
Primary Examiner  
Art Unit 1753